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AS

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/111,482	07/08/98	KIGUCHI	H 101111

IM22/0521

OLIFF AND BERRIDGE
P O BOX 19928
ALEXANDRIA VA 22320

EXAMINER

YAMNITZKY, M

ART UNIT	PAPER NUMBER
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1774

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DATE MAILED: 05/21/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/111,482

Applicant(s)
Hiroshi KIGUCHI et al.

Examiner
M. Yamnitzky

Art Unit
1774



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 22, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-14, and 16-31 is/are pending in the application.
- 4a) Of the above, claim(s) 18-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-14, 16, and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on 8/1/26/01 is: a) ☒ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/26/01, which includes a proposed drawing correction, amendments to the specification, amendments to claims 1, 6 and 14 and cancellation of claim 15, has been entered.

Claims 1, 2, 4-14 and 16-31 are pending.

2. Claims 18-31 stand withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention, the requirement having been traversed telephonically and in Paper No. 12.

3. The objection to the amendment filed 07/13/00, as set forth in Paper No. 14, is overcome by the proposed drawing correction filed 01/26/01, which has been approved by the examiner.

All rejections of claim 15 are rendered moot by the cancellation of claim 15.

The rejection of claims 6 and 14 under 35 U.S.C. 112, second paragraph, as set forth in Paper No. 14, is overcome by applicants' amendment.

The claim rejections based on the Shi patent (5,665,857) are withdrawn, subject to clarification of support in the original disclosure for the limitation set forth in amended claim 1

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requiring that the dye have "substantially no substituent that is able to attach to the precursor polymer" and subject to clarification of the scope of this limitation. Shi requires a dye that is able to attach to the polymer precursor and thus does not appear to meet this claim limitation, but use of the term "substantially" raises a question as to whether a dye have a substituent that is able to attach to the polymer precursor is completely excluded from the claimed composition (see the rejection under 35 U.S.C. 112, second paragraph set forth later in this Office action).

4. Claims 1, 2, 4-14, 16 and 17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 has been amended to limit the at least one fluorescent dye in the composition to a dye that "has substantially no substituent that is able to attach to the precursor polymer".

Applicants state that Tables 1-7 of the original disclosure provide support for this claim limitation.

Any negative limitation or exclusionary proviso must have basis in the original disclosure. See *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738F.2d 453 (Fed. Cir. 1984). The mere absence of a positive limitation is not basis for an exclusion. In the present case, there is no basis for excluding dyes that have one or more substituents that are able to attach to the precursor polymer.

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It is not clear to the examiner that dyes used for the compositions set forth in Tables 1-7 have (substantially) no substituent that, under any circumstance, is able to attach to the precursor polymer. Support for this limitation in the original disclosure is also not clear since the original disclosure teaches that various fluorescent dyes may be used and broadly teaches that “derivatives” of these dyes may be used, with no suggestion that dyes having a substituent that is able to attach to the precursor polymer are excluded from the proposed invention.

5. Claims 1, 2, 4-14, 16 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The scope of a dye that has “substantially no substituent that is able to attach to the precursor polymer” is not clear. The term “substantially” is relative. This limitation is not described in the application as originally filed so the specification does not provide sufficient guidance for determining the scope of this limitation. It is not clear if “substantially no” allows for the presence of some substituent(s) that is/are able to attach to the precursor polymer. To put it another way, are there dyes within the scope of dyes having “substantially no” substituent that is able to attach to the precursor polymer that are not within the scope of dyes having “no” substituent that is able to attach to the precursor polymer?

6. Miscellaneous: The last word in line 2 of claim 6 is misspelled.

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7. The reference made of record and not relied upon is considered pertinent to applicant's disclosure.

WO 98/32783 does not constitute prior art but is of interest because it teaches ink-jet printing of PPV precursors in the manufacture of organic EL devices.

8. Any inquiry concerning this communication should be directed to Marie R. Yamnitzky at telephone number (703) 308-4413. The examiner can generally be reached at this number from 6:45 a.m. to 3:15 p.m. Monday-Friday.

The current fax numbers for Art Unit 1774 are (703) 305-3599 for official after final faxes and (703) 305-5408 for all other official faxes. (Unofficial faxes for Art Unit 1774 can be sent to (703) 305-5436.)

MRY
05/18/01



MARIE YAMNITZKY
PRIMARY EXAMINER

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